



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,306	08/18/2003	Graeme John Proudler	B-5202 621167-5	4171

7590 04/03/2007
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
----------	--------------

2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/643,306	PROUDLER, GRAEME JOHN	
	Examiner	Art Unit	
	Beemnet W. Dada	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/19/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Chankya B. Dey
AU2135

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/23/07, 6/21/06, 7/17/06</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>11/24/03, 9/22/03, 8/18/03</u> | |

DETAILED ACTION

1. In a preliminary amendment file don 08/18/2003 Claim 23 has been amended. Claims 1-49 have been examined.

Claim Objections

2. Claims 1, 33, 44, 45, 46, and 49 are objected to because of the following informalities:

Claim 1 recites the limitations "the processing of data" and "the instantiation". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 33 recites the limitations "the processing of data" and "the use of". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 44 recites the limitations "the use" and "the constraints". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 45 recites the limitations "the use" and "the security device". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 46 and 49 recites the limitation "the processing of data" and "the security device". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

3. Claim 46 is objected to because of the following informalities: the term 'usage' in line 5 of the claim is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Art Unit: 2135

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-32, 43 and 49, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claims 1 and 43 are directed to controlling processing of data by applying usage rules.

The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed steps do not result in a tangible result.

Claims 1-32 and 43 are rejected as being directed to an abstract idea (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process claim must set forth a practical application of that 101 judicial exception to produce **a real-world result**, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77]. Claims 2-32 depend from claim 1 and are rejected under the same rationale.

7. Claims 43 and 49 are directed to controlling processing of data by applying usage rules.

The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. Claims 43 and 49 are directed to functional descriptive material (i.e., software/computer program). Claims 43 and 49 are rejected as being directed to functional descriptive material (i.e., computer program).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2135

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-43 and 45-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Raley et al. US 2003/0196119 A1 (hereinafter Raley).

10. As per claims 1 and 43, Raley teaches a method of controlling the processing of data, wherein the data comprises a plurality of usage rules for a plurality of data items (i.e., plurality of usage rights applied to Documents 222, see figure 2 and page 4, paragraph 0050), and comprising applying individualized usage rules to each of the data items based on measurement of integrity of a computing entity to which the data items are made available (i.e., based on verification of the integrity of the environment of the client 230, see figure 2, page 4, paragraph 0052-page 5, paragraph 0054 and pages 11-12 claim 1], such that the instantiation of the data at the computing entity depends on the integrity of the computing entity [page 4, paragraph 0052-page 5, paragraph 0054] (Note that the limitation after the phrase 'such that' is not given patentable weight since it is an intended use recitation that doesn't result in a structural difference between the claimed invention and the prior art of record).

11. As per claims 33, 45 and 49, Raley teaches a method of controlling the processing of data, wherein the data comprises a plurality of data items, said rule acting to define the use of the data or security to be observed when processing the data (i.e., plurality of usage rights applied to Documents 222, see figure 2 and page 4, paragraph 0050), and in which forwarding of the data is performed in accordance with mask means (i.e., encryption/decryption) provided in association with the rules [pages 4-5, paragraph 0053].

12. As per claim 46, Raley teaches a method of controlling the processing of data, wherein the data comprises a plurality of usage rules for a plurality of data items (i.e., plurality of usage rights applied to Documents 222, see figure 2 and page 4, paragraph 0050), and the method comprising applying individualized usage rules to each of the data items based on a measurement of integrity of a computing entity to which the data items are to be made available (i.e., based on verification of the integrity of the environment of the client 230, see figure 2, page 4, paragraph 0052-page 5, paragraph 0054 and pages 11-12 claim 1] in which at least some of the usage rules comprises masking instructions for masking the associated data items [pages 4-5, paragraph 0053].

13. As per claims 2-4, 47 and 48, Raley further teaches the method in which at least some of the usage rules comprises masking instructions for masking the associated data items [paragraphs 0050 and 0053].

14. As per claim 5, Raley further teaches the method in which the usage rules define security rules for the associated data [paragraphs 0050 and 0053].

15. As per claims 6-8 and 39, Raley further teaches the method in which the data may be transferred between a plurality of computing entities and the instantiation of the data at each computing entity depends on the capabilities of that entity [page 4, paragraph 0052-page 5, paragraph 0054].

Art Unit: 2135

16. As per claims 9-11, Raley further teaches the method in which a computing entity can reliably and irrevocably deny future access to selected data items [page 4, paragraph 0053].

17. As per claim 12, Raley further teaches the method in which computing entities negotiate with one another concerning the use of the data before the data is made available (i.e., usage rights) [paragraph 0050].

18. As per claims 13, 14 and 40, Raley further teaches the method in which the data has constraints defining conditions for use of the data (i.e., usage rights) [paragraph 0050].

19. As per claims 15-17 and 41, Raley further teaches the method in which the data further includes test data [paragraph 0065].

20. As per claims 18 and 19, Raley further teaches the method in which a node requesting access to the data supplies hostage material to the node issuing the data prior to the issuance of the data [paragraph 0065].

21. As per claims 20-23 and 42, Raley further teaches the method in which a node finding itself in possession of data whose history or content do not meet predetermined requirements, formats the data and places it in a repository [paragraphs 0108-0109].

22. As per claims 24-27, Raley further teaches the method in which a node wishing to present the data for retrieval places the data in a repository [see figure 2].

Art Unit: 2135

23. As per claims 28 and 29, Raley further teaches the method in which constraints associated with the data determine whether the data will process on anything other than a trusted computing platform [paragraph 0050].

24. As per claims 30-32, Raley further teaches the method in which the security contracts are stored separately from the data [paragraph 0050 and figure 2].

25. As per claim 34 Raley further teaches the method in which the mask comprises at least one of a symmetric encryption string, symmetric encryption key, and an asymmetric encryption key [paragraph 0050].

26. As per claim 35, Raley further teaches the method in which the rules associated with the data items are adhered to in preference to data handling rules associated with a computing entity processing the data [paragraphs 0050-0054].

27. As per claims 36-38, Raley further teaches the method in which at least some of the rules comprise masking instructions for masking the associated data items [paragraphs 0050 and 0054].

28. Claim 44 is rejected under 35 U.S.C. 102(e) as being anticipated by Rabin et al. US 6,697,948 B1 (hereinafter Rabin).

29. As per claim 44, Rabin teaches a processing system for processing private data (i.e., software) [column 32, lines 25-49], wherein the data comprises a plurality of data fields and

Art Unit: 2135

each filed is associated with customization data that controls the use and propagation of the data (i.e., a tag associated with each instance of software) [column 32, lines 41-53], and wherein the processing system is subservient to the constraints deferred by the customization data [column 32, lines 41-53].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Beemnet W Dada

Beemnet W. Dada
AU2135

Application/Control Number: 10/643,306

Page 9

Art Unit: 2135

March 29, 2007